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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/881,096 06/24/97 SPEICHER

G 935-008

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TM02/0518

EXAMINER

CHAMPAGNE, D

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

05/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/881,096

Applicant(s)

SPEICHER, GREGORY J.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-46 and 48-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-46 and 48-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Response to Amendment*

1. Applicants' arguments filed 27 December 2000 (Paper No. 7) have been fully considered but they are not persuasive, and the amendments therein were not found to patentably distinguish the claims from the prior art. A final action follows.

### *Drawings*

2. The drawings are objected to because a part at the right of Fig. 1 is labeled "PSTN", while that same part is described as the "PTN" in the text (beginning at p. 11 line 3). Correction is required.

### **Support for the Taking of Official Notice**

3. Applicant (p. 18) requested support for the taking of Official Notice in the Office action. Such support is provided by Rondeau, which teaches initiating a telephone call from a web page (col. 3 lines 3-10).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

5. Claims 3-46 and 48-50 are rejected under 35 USC 103(a) as obvious over Hyodo in view of Rondeau.
6. Hyodo teaches (independent claims 3 and 35, col. 3 lines 13-26 and col. 4 lines 12-31) a method and apparatus for providing a computer-based advertising system, the method comprising: an advertiser placing an advertisement; storing and publishing the advertisement; receiving a first connection from a user via the Internet in response to the advertisement; initiating a second voice connection with the advertiser via telephone; and

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coupling the first and second connections, whereby a voice connection between user and advertiser ensues.

7. Hyodo does not teach that the Internet connection is a voice connection. Rondeau teaches (col. 3 lines 3-10) Internet voice connection. Because the service would be enhanced by permitting users to talk to advertisers directly from their PCs, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Internet voice connection to the teaching of Hyodo. The Rondeau teaching also reads on an Internet telephone call or real time Internet communication (independent claims 15 and 25).
8. Hyodo does not teach (independent claim 9) that the first connection is via telephone while the second voice connection is via the Internet. Because the service would be enhanced by permitting users either path for initiating and continuing the dialogue, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add this flexibility to the teaching of Hyodo.
9. Neither of the references teach (claims 4, 10, 16, 26 and 36) maintaining anonymity of the advertiser. This is a well-known property of personals ads.
10. Hyodo also teaches (claims 5, 8, 11, 14, 21, 24, 31, 34, 37 and 40) text advertising (the toll-free number, col. 2 lines 34-35) and charging the advertiser (col. 4 lines 50-55).
11. In the last Office action, filed 20 June 2000 (Paper No. 5), examiner took official notice that the added limitations of independent claim 41 and dependent claims 6, 7, 12, 13, 17-20, 22, 23, 27-30, 32, 33, 38, 39, 40-46 and 48-50 were common or otherwise obvious. Applicant has not seasonably traversed these allegations by the examiner, where a traverse requires adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). Hence these added limitations are taken to be well known prior art.

#### Outstanding Issues and Examiner's Discussion

12. Applicant argues (p. 15) that the principal reference, Hyodo, does not teach coupling the first connection with the second connection. But the claims are written in broad, common language. Independent claims 3, 9 and 35 are limited to receiving, initiating and coupling, without limitation as to who or what is doing the receiving, initiating and coupling. The verb "coupling" is widely understood to mean connecting (Webster's 10<sup>th</sup> Collegiate). Hyodo

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teaches connecting and therefore coupling.

13. Hyodo's essential contribution is connecting the user and advertiser, using a relatively simple technology. Rondeau teaches an advanced connection technology. It would take no more than ordinary skill in the art to see how the technology of Rondeau would enhance the Hyodo business method. Since Rondeau teaches essentially all the technology, technical success in implementation would be assured.

#### Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
15. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is (703)308-3331. The examiner's normal work schedule is 6:30 AM to 5 PM ET Monday through Thursday.

DLC  
14 May 2001

  
ERIC W. STAMBER  
PRIMARY EXAMINER